

Application No. 10/777,572
Reply to Office Action of May 3, 2006

REMARKS

I. General

Claims 1-31 are pending in the application. The issues in the Office Action mailed May 3, 2006 are as follows:

- Claims 1, 4-26, 28-31 were rejected under 35 U.S.C. § 103(a) as being obvious over US Patent No. 5,353,788.
- Claims 2, 3, 27 were rejected under 35 U.S.C. § 103(a) as being obvious over US Patent No. 5,353,788 in view of US Patent No. 6,532,961.

Applicant hereby traverses the outstanding rejections and objections and requests reconsideration and withdrawal in light of the remarks and amendments contained herein.

II. Claim Rejections 35 USC 103(a).

Claims 1, 4-26, 28-31 were rejected under 35 U.S.C. § 103(a) as being obvious over US Patent No. 5,353,788, the "Miles" patent.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143.

Claim 1: Claim 1 requires an EEG sensor located on a forehead support. The Office Action admits that *Miles* does not disclose the forehead support having an EEG sensor located thereon. The Office Action attempts to cure this deficiency by suggesting that the location of the EEG sensor is not critical. It is submitted that the location of an EEG sensor is critical and that it would not have been obvious to locate an EEG sensor on the mask assembly of *Miles*. The prior art teaches cap-based EEG sensors, such as disclosed in US Pat. 5,293,867, wherein

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the positioning of individual sensors is carefully predetermined in order to acquire meaningful EEG signals. As *Miles* does not teach or suggest at least this feature of claim 1, Applicant respectfully asserts that claim 1 is patentable over the 35 U.S.C. § 103 rejection of record.

It is well settled that the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness, M.P.E.P. § 2143.01. The cited motivation is merely a statement that *Miles* can be modified, and does not state any desirability for making the modification. The mere fact that *Miles* can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification. As no valid suggestion has been made as to why placing an EEG on a forehead support of *Miles* is desirable, the rejection of claims 1 should be withdrawn.

Claim 4: Claim 4 requires an SP02 sensor located on a forehead support bar. The Office Action suggests that it would have been obvious to one of ordinary skill in the art to place such a sensor in a forehead support bar in view of *Miles*. To establish a *prima facie* case of obviousness, the prior art cited must teach or suggest all the claim limitations. *Miles* does not teach a forehead support bar nor does it teach positioning an SP02 sensor on the forehead support bar. As *Miles* does not teach or suggest at least these two features of claim 4, Applicant respectfully asserts that claim 4 is patentable over the 35 U.S.C. § 103 rejection of record.

Claim 5. Claim 5 requires an EEG sensor including a pad of conductive carbonized rubber material. The Office Action makes no mention of such structure. To establish a *prima facie* case of obviousness, the prior art cited must teach or suggest all the claim limitations. As *Miles* does not teach an EEG sensor having a conductive rubber material, Applicant respectfully asserts that claim 5 is patentable over the 35 U.S.C. § 103 rejection of record.

Claim 6. Claim 6 requires a sensor located on a strap extending from the mask. The Office Action suggests that it would have been obvious to one of ordinary skill in the art to place

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such a sensor in a strap in view of *Miles*. To establish a prima facie case of obviousness, the prior art cited must teach or suggest all the claim limitations. *Miles* does not teach positioning a sensor on a strap. As *Miles* does not teach or suggest at least this feature of claim 6, Applicant respectfully asserts that claim 6 is patentable over the 35 U.S.C. § 103 rejection of record.

Claim 7: For the reasons relating to claims 1 and 5 above, it is submitted that *Miles* does not teach a conductive material adapted to measure an EOG.

Claims 8 - 13: Claim 8 requires a processor adapted to determine the existence of a sleep disorder and to adjust the gas delivery setting based on such determination. The Office Action suggests that *Miles* teaches such a processor for determining the existence of a sleep disorder simply referring to Figure 2 of *Miles*. To establish a prima facie case of obviousness, the prior art cited must teach or suggest all the claim limitations. *Miles* does not teach a processor for determining the existence of a sleep disorder or adjusting a gas delivery setting based on such a determination. Applicant respectfully asserts that claims 8-13 are patentable over the 35 U.S.C. § 103 rejection of record.

Claims 14 - 16: Claim 14 requires a processor adapted to determine the state of arousal and to adjust the gas delivery setting based on such determination. The Office Action makes no reference to *Miles* as teaching a processor for determining the state of arousal of a subject. To establish a prima facie case of obviousness, the prior art cited must teach or suggest all the claim limitations. *Miles* does not teach a processor for determining the state of arousal or adjusting a gas delivery setting based on such a determination. Applicant respectfully asserts that claims 14-16 are patentable over the 35 U.S.C. § 103 rejection of record.

Claims 17-20: Claim 17 requires determining a sleep state of a subject and adjusting output of a gas delivery device based on the determined sleep state. The Office Action suggests that *Miles* discloses structures that can be used to perform steps cited in claims 17-20. To establish a prima facie case of obviousness, the prior art cited must teach or suggest all the claim limitations. *Miles* does not teach the structure of a processor for determining subject sleep state, and there exists no structure in *Miles* capable of performing the steps of determining subject

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sleep state. Applicant respectfully asserts that claims 17-20 are patentable over the 35 U.S.C. § 103 rejection of record.

Claims 21, 22: Claim 21 requires the method of attaching a light source at the mask and a light sensor positioned to contact the subject's forehead. The Office Action suggests that *Miles* discloses structures that can be used to perform steps cited in claims 21, 22. To establish a prima facie case of obviousness, the prior art cited must teach or suggest all the claim limitations. *Miles* does not teach the structure of mask with a light source and a light sensor positioned at the subject's forehead. Applicant respectfully asserts that claims 21, 22 are patentable over the 35 U.S.C. § 103 rejection of record.

Claim 22: Claim 22 requires a mask with a first thermal sensor positioned on an interior mask surface and a second thermal sensor positioned on an exterior mask surface. The Office Action makes no reference to *Miles* as teaching a pair of separately positioned thermal sensors. To establish a prima facie case of obviousness, the prior art cited must teach or suggest all the claim limitations. As *Miles* does not teach these limitations, Applicant respectfully asserts that claim 22 is patentable over the 35 U.S.C. § 103 rejection of record.

Claim 23, 24: Claim 23 requires a mask having a body position sensor attached thereto. The Office Action makes no reference to *Miles* as teaching a body position sensor attached to the mask. To establish a prima facie case of obviousness, the prior art cited must teach or suggest all the claim limitations. As *Miles* does not teach these limitations, Applicant respectfully asserts that claims 23, 24 are patentable over the 35 U.S.C. § 103 rejection of record.

Claim 25: Claim 25 requires a mask having a plurality of thermally conductive surfaces distributed throughout a perimeter surface. The Office Action makes no reference to *Miles* as teaching mask having a plurality of thermally conductive surfaces at a mask perimeter. To establish a prima facie case of obviousness, the prior art cited must teach or suggest all the claim limitations. As *Miles* does not teach these limitations, Applicant respectfully asserts that claim 25 is patentable over the 35 U.S.C. § 103 rejection of record.

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Claims 26-29: The arguments of claim 1 apply to claims 26-29, i.e., *Miles* does not disclose a forehead support having a sensor located thereon.

Claim 29: As *Miles* does not teach the limitation of a mask seal leakage detector, Applicant respectfully asserts that claim 29 is patentable over the 35 U.S.C. § 103 rejection of record.

Claims 30-31: Claim 30 requires a processor in communication with a cardiac pacemaker adapted to adjust gas delivery to the subject based on a signal from the pacemaker. The Office Action makes no reference to *Miles* as teaching a pacemaker. To establish a prima facie case of obviousness, the prior art cited must teach or suggest all the claim limitations. As *Miles* does not teach this limitation, Applicant respectfully asserts that claims 30-31 are patentable over the 35 U.S.C. § 103 rejection of record.

Claim 31: Claim 31 requires a processor adapted to determine the existence of a sleep disorder of a subject. The Office Action makes no reference to *Miles* as teaching a processor for determining a sleep disorder of the subject. To establish a prima facie case of obviousness, the prior art cited must teach or suggest all the claim limitations. As *Miles* does not teach a processor for determining a sleep disorder, Applicant respectfully asserts that claim 31 is patentable over the 35 U.S.C. § 103 rejection of record.

III. Claim Rejections 35 USC 103(a).

Claims 2, 3, 27 were rejected under 35 U.S.C. § 103(a) as being obvious over US Patent No. 5,353,788 in view of US Patent No. 6,532,961 ("Kwok").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to

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combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143.

Claim 2: Claim 2 requires a thermosensitive coating at a perimeter surface of a mask. Since neither Kwok nor Miles disclose a thermosensitive coating at a mask perimeter, Applicant respectfully asserts that claim 2 is patentable over the 35 U.S.C. § 103 rejection of record.

Claim 3: As a dependent claim of claim 1, the arguments of claim 1 apply to claim 3. Applicant respectfully asserts that claim 3 is patentable over the 35 U.S.C. § 103 rejection of record.

Claim 27: As a dependent claim of claim 26, the arguments of claim 26 apply to claim 27. Applicant respectfully asserts that claim 26 is patentable over the 35 U.S.C. § 103 rejection of record.

IV. Conclusion

In view of the above remarks and amendment, Applicant believes the pending application is in condition for allowance. Applicant includes an Information Disclosure Statement by Applicant, PTO/SB/08A (2 pages) with this response. Any fees associated with this response, including but not limited to IDS fees and extension of time fees, may be charged to the deposit account of the undersigned, Dep. Acctn. #50-1212(ref. 10310190)

Respectfully submitted,
Compumedics Limited, BY ITS ATTORNEYS

Dated this September 4, 2006


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